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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,414	07/21/2003	Ying-Duo Gao	20329YDD	7262

7590 04/21/2004  
Patent Department  
Merck & Co., Inc.  
P.O. Box 2000  
Rahway, NJ 07065-0907

EXAMINER

HABTE, KAHSA Y

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/624,414

Applicant(s)

GAO ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-2 (in part), 3-6, 7 (in part), 8-11, 17-18 (in part) and 23-25 (in part), drawn to indoles where both **V** and **W** in formula I are C; **Z** is N and **X** = N, classified in class 546, subclass 17.
  - II. Claims 1-2 (in part), 7 (in part), 12 (in part), 13-14, 17-18 (in part) and 23-25 (in part), drawn to spiro-piperidines where both **V** and **W** in formula I are C; **Z** = C and **X** is N, classified in class 546, subclass 15.
  - III. Claims 1-2 (in part), 7 (in part), 12 (in part), 15-16, 17-18 (in part) and 23-25 (in part), drawn to indoles where both **V** and **W** in formula I are C; **Z** = N and **X** is C, classified in class 548, subclass 408.
  - IV. Claims 1-2 (in part), 7 (in part), 17-18 (in part), 19-22 and 23-25 (in part), drawn to others, classified in classes 544, 546, 548, 564, subclass various.

The inventions are distinct, each from the other because of the following reasons: Groups I-IV are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of **V**, **W**, **Z** and **X** in formula I do not belong to the same recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others. For example, Group I is drawn to indoles spiro-fused to piperidine (**V** = **W** = CH and **X** = **Z** = N) and is different from

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Groups II-IV, since this core structure is not present in Groups I or II. Group II is drawn to spiro-piperidines fused to indenyl ( $V = W = Z = CH$  and  $X = N$  and is different from Groups I or III-IV. Group III is drawn to indoles fused to cyclohexyl ( $V = W = X = CH$  and  $Z = N$ ) and is different from Groups I-II or IV. Group IV is drawn to others (e.g.  $V$  and  $W = N$  or one of  $V$  or  $W$  is  $N$ , etc.) and is different from Groups I-III. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structure equivalents of each other.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

If applicants elected Group IV, a tentative election of species is required.

A telephone call was made to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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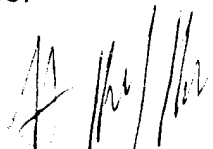
**Conclusion**

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

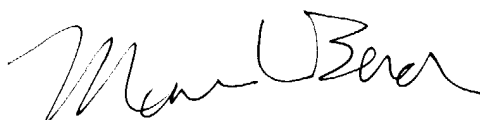
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624



Mark L. Berch  
Primary Examiner  
Art Unit 1624

KH  
April 16, 2004